

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN FEENEY and CHRIS WALDECK

Appeal No. 2002-0979
Application No. 09/248,595

ON BRIEF

MAILED

JAN 27 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 8-12, 17 and 18, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to game balls, such as footballs, having improved moisture resistance (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Friese et al. (Friese)	4,755,187	Jul. 05, 1988
Walters	5,069,935	Dec. 03, 1991

The following rejection is before us for review.

Claims 1-6, 8-12, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Friese in view of Walters.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 23) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 22 and 24) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims 1-6, 8-12, 17 and 18 as being unpatentable over Friese in view of Walters, the examiner finds that Friese discloses a method of waterproofing leather including tanning using fatliquoring agents. As noted by Friese (column 3, lines 46-49), the leathers obtained by the disclosed process are soft with a pleasant "lardy"

feel and are "particularly suitable for the production of shoe upper leather, garment quality suede and heavy suede." The examiner concedes that Friese does not teach use of the resulting leather to make a football (or other game ball), but asserts that Friese also does not teach away from such use of the leather (answer, page 3).

According to the examiner, it would have been obvious, in view of the teachings of Walters of a game ball with a tanned leather cover having moisture resistance properties, to use the "fatliquored" leather of Friese on the football of Walters "in order to provide a waterproofed leather football with improved water proofing properties" (answer, page 4). For the reasons set forth on pages 15-17 of appellants' brief, we do not agree with the examiner. As pointed out by appellants, Walters specifically teaches that the key to the Horween leather used for making American footballs is its "tanned-in tack" (column 1, lines 24-34); an "oily, slippery feeling is not acceptable since it affects the playability of the football" (column 4, lines 36-37). Accordingly, one of ordinary skill in the art at the time of appellants' invention would have appreciated from the teachings of Walters that the "lardy" (oily, slippery) characteristic of the leather produced using Friese's tanning process would have rendered such leather unsuitable for use in making an American football.

Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353,

1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accordingly, in light of the above discussion, we conclude that one of ordinary skill in the art at the time of appellants' invention would not have been motivated to make the combination proposed by the examiner. It thus follows that we cannot sustain the examiner's rejection.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 11 is rejected under 35 U.S.C. § 102(b) as being anticipated by Walters.

Claim 11 reads as follows:

A game ball having improved resistance to water absorption comprising a cover of natural leather having a treatment to impart improved water resistant properties throughout the entirety of the leather, said treatment comprising tanning of said leather with chemicals prior to application of said cover to said game ball.

Unlike the remaining claims pending in this application, claim 11 does not recite any specific degree of water resistance. All claim 11 requires is a game ball comprising a cover of a leather which has been treated so as to impart improved water resistance, the treatment comprising tanning with chemicals prior to application of the cover to the game ball. Walters' football is made with a steer hide leather cover which has been tanned using a "chrome type" tannage process followed with a vegetable retannage.

This tanning process will inherently impart some improvement in water resistance. In any event, the additional treatment of the leather panels with polyfluoroalkyl material¹ as disclosed by Walters prior to constructing the football certainly imparts improved water resistance properties to the football cover, as taught by Walters. The Walters football thus meets all of the limitations of claim 11 so as to anticipate² claim 11.

REMAND TO THE EXAMINER

We remand this application to the examiner in accordance with 37 CFR § 1.196(a) for consideration of whether the particular water resistance standards recited in claims 1-6, 8-10, 12, 17 and 18 are supported by the application as originally filed so as to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112. While Tables 1(A) and 1(B) may disclose examples of appellants' invention which fall within the ranges of wet to dry ratios recited in these claims, it is not immediately apparent to us where support is found in the application as originally filed for the full scope of the presently claimed ranges.

¹ Such additional treatment to help impart the improved water resistant properties is not precluded, in light of the use of the term "comprising" in claim 1 following "treatment," since the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements. See In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948)("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

² Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Taking claim 1 as an example, Table 1(B) of appellants' specification (page 15) discloses one tested example of appellants' invention wherein the ratio of the ball weight with absorbed water to the dry ball weight after being subjected to three 90 minute cycles of a rain test is 1.13:1, which is clearly less than the recited maximum of 1.25:1. Appellants' original disclosure, however, does not appear to convey possession of the full range (up to a maximum of 1.25:1) of weight ratios now recited in claim 1.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Applying this standard, upon remand, the examiner should review the specification and claims to determine whether appellants' original disclosure provides written descriptive support for the subject matter now recited in claims 1-6, 8-10, 12, 17 and 18. If the examiner is unable to identify where in appellants' original disclosure support can be found for each of the ratio ranges recited in these claims, the examiner should consider rejecting the claims under the first paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 8-12, 17 and 18 under 35 U.S.C. § 103 is reversed. A new rejection of claim 11 is entered pursuant to 37 CFR § 1.196(b) and the application is remanded to the examiner for consideration of the written description issue discussed above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR §§ 1.196(a) and (e).

37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(e) provides that:

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED; 37 CFR § 1.196(b) and REMANDED

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Michelle Bugbee, Associate Patent Counsel
Spalding Sports Worldwide, Inc.
425 Meadow Street
P.O. Box 901
Chicopee, MA 01021-0901